REMARKS

Claims 1-20 were pending in this application.

Claims 1-11 have been rejected in the Office Action.

Claims 12-20 have been restricted and withdrawn in the Office Action.

Claims 1, 2, 4, 5, and 7-9 have been amended as shown above.

Reconsideration and full allowance of all pending claims are respectfully requested.

I. ELECTION / RESTRICTION REQUIREMENT

The Office Action asserts that Claims 12-20 are directed to an invention that is independent or distinct from the invention claimed in Claims 1-11. In particular, the Office Action asserts that Claims 12-20 are directed to an invention that is independent or distinct because "the shield and antenna are not required to be on the same side of the substrate as the semiconductor device as required in" Claims 1-11. The Office Action then withdraws Claims 12-20 from consideration.

The Office Action incorrectly interprets Claims 12-20 in making the restriction.

Claim 12 recites a substrate with "a side," a semiconductor device mounted on "the side" of the substrate, a shield mounted on "the side" of the substrate, and an antenna mounted over "the side" the substrate.

Claim 12 clearly recites that the semiconductor device and the shield are mounted on "the side" of the substrate and that the antenna is mounted over "the side" of the substrate. As a result, at least a portion of the semiconductor die, shield, and antenna recited in Claim 12 are on the same side

of the substrate.

Similarly, Claim 19 recites a substrate, a semiconductor device mounted on the substrate, a shield mounted on the substrate and (together with the substrate) enclosing the semiconductor device, and an antenna or antenna support mounted over the shield and (together with the substrate) enclosing the shield.

Claim 19 clearly recites that the semiconductor die and the shield are mounted on the substrate. Claim 19 also clearly recites that the shield and the substrate enclose the semiconductor device. As a result, at least a portion of the shield and the semiconductor die recited in Claim 19 are on the same side of the substrate. In addition, Claim 19 clearly recites that the antenna or antenna support is mounted over the shield and that the antenna or antenna support and the substrate enclose the shield. As a result, at least a portion of the antenna or antenna support and the shield recited in Claim 19 are on the same side of the substrate.

The Office Action improperly interprets Claims 12 and 19 in making the restriction. As a result, the restriction is improper. Accordingly, the Applicants respectfully request withdrawal of the restriction and full examination of Claims 1-20.

II. FINALITY OF OFFICE ACTION / AMENDMENTS TO CLAIMS

The restriction and withdrawal of Claims 12-20 are improper. As a result, Claims 12-20 should have been examined, and the Office Action should not have been made final. Moreover, because the Office Action should not have been made final, the Applicants are entitled to amend the

claims, and those amendments may not be refused entry. The Applicants respectfully request withdrawal of the finality of the Office Action.

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-3, 5, 6, and 8-11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,118,672 to Yamauchi et al. ("*Yamauchi*"). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Yamauchi recites a tuner structure. (*Abstract*). The tuner structure includes a substrate (element 6) and a tuner body (element 7). (*Col. 8, Lines 9-20*). The tuner body includes "chip components" (element 2), a circuit board (element 1), and upper and lower "shield covers" (elements 9). (*Col. 8, Lines 12-23*).

Different sections of the Office Action assert that different elements of *Yamauchi* anticipate the "antenna" recited in Claim 1. The Office Action first asserts that the tuner body (element 7) of *Yamauchi* anticipates the antenna of Claim 1. (*Office Action, Page 3, First paragraph*). The Office Action later asserts that *Yamauchi* discloses connecting the tuner body to an external antenna and

that the external antenna anticipates the antenna of Claim 1. (*Office Action, Page 6, Fourth paragraph*).

Regarding the first position, *Yamauchi* lacks any mention that the tuner body (element 7) of the tuner structure includes an antenna. Moreover, the chip components (element 2) of the tuner structure are relied upon to anticipate the "semiconductor device" of Claim 1. If the tuner body includes an antenna, the antenna and the semiconductor device would both lie between the two shield covers (element 9). As a result, the shield covers would not be "present between the antenna and the semiconductor device" as recited in Claim 1.

Regarding the second position, the antenna is external to the tuner structure shown in Figure 1. The antenna is not actually mounted to the circuit board (element 1) or the substrate (element 6) of the tuner structure. As a result, the antenna is not "mounted on the substrate" as recited in Claim 1.

Based on this, both interpretations of *Yamauchi* fail to anticipate all elements of Claim 1. As a result, the Office Action fails to show that *Yamauchi* anticipates the Applicants' invention as recited in Claim 1 (and its dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1-3, 5, 6, and 8-11.

IV. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 4 and 7 under 35 U.S.C. § 103(a) as being unpatentable over *Yamauchi* in view of U.S. Patent No. 6,356,173 to Nagata et al. ("*Nagata*"). This rejection is

respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or

suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above, the Office Action fails to show that *Yamauchi* anticipates all elements of Claim 1. *Nagata* is not cited by the Office Action as disclosing, teaching, or suggesting any element in Claim 1. As a result, the Office Action fails to show that the proposed *Yamauchi-Nagata* combination discloses, teaches, or suggests all elements of Claims 4 and 7, which depend from Claim 1.

For these reasons, the Office Action does not establish a *prima facie* case of obviousness against Claims 4 and 7. Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 4 and 7.

V. CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Deposit Account No. 50-0208. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and please charge the fee for this extension to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Nov. 4, 2003

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